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SEP 22 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Pisutha-Arnond et al. )  
For: Message Alert System and )  
Method of Providing Message )  
Notification )  
Serial No.: 09/504,135 )  
Filed: February 15, 2000 )  
Examiner: Persino, R. )  
Art Unit: 2682 )

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being  
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September 22, 2005

(Date)

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

**TRANSMITTAL OF APPEAL BRIEF, AMENDMENT after FINAL, and  
PETITION REQUESTING A FOUR MONTH EXTENSION**

The enclosed brief is being filed in furtherance of the Notice of Appeal, faxed on March 22, 2005. The present filing date of September 22, 2005, represents the original permissible two month term for filing the present brief, extended an additional four months.

In connection with filing the appeal brief, a total fee in the amount of \$2,090 including a \$500 fee associated with filing an appeal brief, and a \$1,590 fee associated with requesting a four month extension, is believed to be due, as provided by C.F.R. §41.20(b)(2) and C.F.R. §1.17(a)(4). The undersigned authorizes the Commissioner and respectfully requests that these fees be charged to deposit account 50-2117 of Motorola, Inc. The Commissioner is further authorized to charge any additional fees deemed to be necessary in connection with the proper

handling and consideration of the enclosed appeal brief in support of the appeal from the Examiner's final rejection, and the Amendment after FINAL, and/or credit any overpayments to deposit account 50-2117 of Motorola, Inc.

Respectfully submitted,

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APPELLANTS' BRIEF

This brief is in furtherance of the NOTICE OF APPEAL, communicated via facsimile on March 22, 2005.

Any fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)):

|    |                                   |  |
|----|-----------------------------------|--|
| I  | REAL PARTY IN INTEREST            | 09/26/2005 MBINAS 00000017 502117 09504135 |
| II | RELATED APPEALS AND INTERFERENCES | 02 FC:1402 500.00 DA                       |

- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF CLAIMED SUBJECT MATTER
- VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII ARGUMENT
  - A. Rejections under 35 U.S.C. 102
- VIII CLAIMS APPENDIX
- XI EVIDENCE APPENDIX (not applicable)
- X RELATED PROCEEDINGS APPENDIX (not applicable)

### **I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Motorola, Inc., a Delaware corporation.

### **II. RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

### **III. STATUS OF CLAIMS**

#### **A. Status of all claims in the proceeding**

1. Claims rejected: 1-26, 28-35, 37-42 and 44-48
2. Claims allowed: none
3. Claims withdrawn: none
4. Claims objected to: none
5. Claims cancelled: 27, 36 and 43

#### **B. Identification of claims being appealed**

The claims on appeal are: 35, 37-42 and 44-48

#### IV. STATUS OF AMENDMENTS

An amendment, dated September 22, 2005, is being filed at the same time as the present appeal brief. The Examiner has not yet had a chance to consider the amendment, consequently the amendment to the claims has not yet been entered.

#### V. SUMMARY OF THE CLAIMED SUBJECT MATTER

A first aspect of the present invention, which is being appealed, pertains to a message alert system for a communication device (10) wherein the communication device comprises a processor (30) and a display (12) for displaying information. The message alert system includes a computer-readable medium (32, 34), and a routine stored in the computer-readable medium (page 5, lines 14-16) and configured for execution by the processor (30). The routine includes a first routine that receives a message comprising the information (100) (page 7, lines 19-20). The routine further includes a second routine that analyzes the message to determine a size thereof (124), and further analyzes the message to determine whether the message is of a message type (102) (page 7, lines 20-22) for which the third routine is executed. The routine still further includes a third routine that generates a display item for the message in accordance with the size thereof (126), if the message is of the type for which the third routine is executed (page 12, line 11 to page 13, line 8) (page 15, lines 8-16).

A further aspect of the present invention, which is being appealed, pertains to a method of controlling a communication device (10) having a display (12) for displaying information. The method includes receiving a message comprising the information (100) (page 7, lines 19-20), and analyzing the message to determine a size thereof (124), and further analyzing the message to determine whether the message is of a message type (102) (page 7, lines 20-22) for which the generating step is executed. A display item is then generated for the message in accordance with the size thereof (126), if the message is of the type for which the generating step is executed (page 12, line 11 to page 13, line 8) (page 15, lines 8-16).

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al., US Patent No. 4,626,842.

## VII. ARGUMENTS

### A. Rejections under 35 U.S.C. 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

#### 1. Whether claims 35, 37-42 and 44-48 have been improperly rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al., US Patent No. 4,626,842.

In attempting to reject claims, the Examiner has alleged that Ichikawa et al., US Patent No. 4,626,842, makes known each and every feature of the respective claims. However contrary to the Examiner's assertions, Ichikawa et al., '842, minimally fails to make known (or obvious) both 1) analyzing the message to determine a size thereof, and further analyzing the message to determine whether the message is of a message type for which the generating step is executed; and 2) generating a display item for the message in accordance with the size thereof, if the message is of the type for which the generating step is executed.

In attempting to address applicants' previous comments relative to the above noted differences, wherein applicant highlighted the distinctive nature of message type, relative to message size, as used in the claim. The Examiner responded by asserting that message type could be a function of size. Even so, if a categorization based upon message size is used to satisfy a categorization based upon message type, it would still require that the size distinction used to satisfy method type would need to be different than the size criteria, that is used as a basis

upon which the display item for the message is generated. In other words, the criteria used to distinguish between message type is used to determine whether the generating step is executed. The display item is then generated for the message in accordance with the size of the message. Presumably, if a message was precluded from having the generating step executed based upon size, than a different size criteria would need to be used to differentiate how the generating step is executed.

In any event, the Examiner has failed to identify two different size criteria used by Ichikawa et al., '842, which could be said to make known or obvious both a determination of "if a generating step is executed" (message type), and if the generating step is executed, a determination as to "how the generating step is executed" (message size). Consequently, Ichikawa et al., '842, fails to make known or obvious, each and every feature of the claims. As a result, the applicants would assert that the rejection of claims 35, 37-42 and 44-48 is improper.

In view of the above analysis, the applicants would assert, that the Examiner has failed to establish that any of the cited references either separately or in combination make known or obvious any of the presently pending claims. The applicants would respectfully request that the Examiner's decision to finally reject the presently pending claims be overturned, and that the claims be permitted to proceed to allowance.

Respectfully submitted,

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**VIII. APPENDIX OF CLAIMS**

The following is the text of the claims involved in this appeal:

1. A message alert system for a communication device wherein the communication device comprises a display and a processor, the message alert system comprising:
  - a computer-readable medium; and
  - a routine stored in the computer-readable medium and configured for execution by the processor, the routine comprising:
    - a first routine that receives a message having a message type; and
    - a second routine that generates a display item for the display of the communication device in accordance with the message type such that the display item comprises information indicative of the message type of the received message and whether further messages of the message type have been received by the communication device.
2. The message alert system of claim 1, wherein the display item provides for execution of a task in light of the received message.
3. The message alert system of claim 2, wherein the task comprises one of reading a text message, playing an answering machine message, contacting a voice mail system and closing the display item.

4. The message alert system of claim 1, wherein the second routine determines whether the further messages of the message type have been reviewed by a user.

5. The message alert system of claim 4, wherein the information of the display item includes an indication of a total number of unreviewed messages of the message type.

6. The message alert system of claim 1, wherein:  
the communication device resides in one of a plurality of operating modes; and  
the routine further comprises a third routine that provides the generated display item to the display of the communication device conditioned upon a current operating mode of the plurality of operating modes.

7. The message alert system of claim 6, wherein:  
the plurality of operating modes comprises a message viewing mode; and  
the third routine provides the generated display item to the display of the communication device once the communication device leaves the message viewing mode.

8. The message alert system of claim 1, wherein the routine further comprises an alert routine that generates one of a plurality of alerts in connection with receipt of the message.

9. The message alert system of claim 8, wherein the routine further comprises an alert

customization routine that provides for selecting one of the plurality of alerts for each message type, respectively.

10. The message alert system of claim 1 in combination with the communication device, wherein:

the communication device comprises a memory having a memory capacity; the routine further comprises a memory check routine that determines whether the received message results in memory utilization that exceeds a predetermined amount of the memory capacity; and

the information of the display item comprises a notification that the predetermined amount of the memory capacity has been exceeded.

11. The message alert system of claim 10, wherein:

the memory check routine further determines whether the received message can be stored in the memory;

the display item provides for accessing stored messages in the memory when the received message cannot be stored in the memory.

12. The message alert system of claim 1, wherein the information of the display item comprises one of a reproduction of a portion of the received message and a reproduction of the received message.

13. The message alert system of claim 1, wherein the routine further comprises a reminder routine that generates a reminder display item for the received message in accordance with the message type.

14. The message alert system of claim 13, wherein:

the routine further comprises an initialization routine; and

the reminder routine is executed only for message types selected by a user during the initialization routine.

15. The message alert system of claim 1, wherein the display comprises a window in which the information is displayed.

16. A method for providing message alerts in a communication device having a display, the method comprising the steps of:

receiving a message having a message type; and

generating a display item such that the display item comprises information in accordance with the message type of the received message such that the information is indicative of the message type of the received message and whether further messages of the message type have been received by the communication device.

17. The method of claim 16, further comprising the step of displaying the generated display item on the display such that the information of the display item directs a user to initiate a

task in light of the received message.

18. The method of claim 16, further comprising the step of determining whether the further messages of the message type have been reviewed by a user.

19. The method of claim 16, wherein the information of the display item includes an indication of a total number of unreviewed messages of the message type.

20. The method of claim 16, further comprising the step of displaying the generated display item conditioned upon an operating mode of the communication device.

21. The method of claim 16, further comprising the step of producing an alert in connection with receipt of the message.

22. The method of claim 21, further comprising the step of selecting a respective alert of a plurality of message alerts for each message type.

23. The method of claim 16, wherein the communication device comprises a memory having a memory capacity such that the method further comprises the steps of:  
determining whether the received message results in memory utilization that exceeds a predetermined amount of the memory capacity; and  
generating further information for the display item comprising a notification that the

predetermined amount of the memory capacity has been exceeded.

24. The method of claim 16, wherein the information of the display item comprises a portion of the received message.

25. The method of claim 16, further comprising the step of generating a reminder display item for the received message in accordance with the message type.

26. A communication device for receiving a message having a message type, comprising:

- a display;
- a processor;
- a memory having a memory capacity; and
- a routine configured for execution by the processor, the routine comprising:
  - a first routine that receives data in connection with the message;
  - a second routine that determines from the data whether storing the message in the memory would result in exceeding a predetermined amount of the memory capacity; and
  - a third routine that generates a display item for the display wherein the display item comprises a notification regarding the memory when storing the message in the memory would result in exceeding the predetermined amount of the memory capacity, and information indicative of the message type of the message.

27. (canceled)

28. The communication device of claim 26, wherein information of the display item is further indicative of one of whether further messages of the message type have been received by the communication device and a size of the message.

29. The communication device of claim 26, wherein the data is indicative of the message.

30. The communication device of claim 26, wherein:  
the second routine further determines whether the memory is at the memory capacity;  
the display item comprises a memory full notification when the memory is at the memory capacity and provides for accessing items stored in the memory.

31. The communication device of claim 26, wherein:  
the message is transmitted via a network to the communication device; and  
the routine comprises a fourth routine that, subsequent to the second routine determining that the memory is not at the memory capacity, transmits a command signal to the network to initiate transmission of the message.

32. A method of controlling a communication device having a display, a processor, and a memory having a memory capacity wherein the communication device is capable of receiving a message, the method comprising the steps of:

receiving data in connection with the message;  
analyzing the data to determine whether storing the message would result in exceeding a predetermined amount of the memory capacity; and  
generating a display item for the display wherein the display item comprises a notification regarding the memory when storing the message in the memory would result in exceeding the predetermined amount of the memory capacity.

33. The method of claim 32, wherein the data is indicative of the message.

34. The method of claim 32, further comprising the steps of:  
determining whether the memory is at the memory capacity such that the display item comprises a memory full notification when the memory is at the memory capacity; and  
providing via the display item access to items stored in the memory when the memory is at the memory capacity.

35. A message alert system for a communication device wherein the communication device comprises a processor and a display for displaying information, comprising:  
a computer-readable medium; and  
a routine stored in the computer-readable medium and configured for execution by the processor, the routine comprising:

a first routine that receives a message comprising the information;  
a second routine that analyzes the message to determine a size thereof, and further

analyzes the message to determine whether the message is of a message type for which the third routine is executed;

a third routine that generates a display item for the message in accordance with the size thereof, if the message is of the type for which the third routine is executed.

36. (canceled)

37. The message alert system of claim 35, wherein the routine further comprises an initialization routine that specifies the message type for which the third routine is executed.

38. The message alert system of claim 35, wherein the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is less than a predetermined size.

39. The message alert system of claim 35, wherein:

the generated display item comprises a reproduction of the message when the second routine determines that the size of the message is greater than a predetermined size; and

the routine comprises a fourth routine that provides the generated display item to the display for a predetermined time.

40. The message alert system of claim 39, wherein:

the routine comprises a fifth routine that generates a further display item that comprises a

portion of the message when the second routine determines that the size of the message is greater than a predetermined size; and

the routine comprises a sixth routine that provides the further display item to the display after the predetermined time has elapsed.

41. The software system of claim 35, wherein:

the message is transmitted to the communication device via a network; and

the network is a broadcast network.

42. A method of controlling a communication device having a display for displaying information, the method comprising the steps of:

receiving a message comprising the information;

analyzing the message to determine a size thereof, and further analyzing the message to determine whether the message is of a message type for which the generating step is executed; and

generating a display item for the message in accordance with the size thereof, if the message is of the type for which the generating step is executed.

43. (canceled)

44. The method of claim 42, further comprising the step of specifying the message type for which the third routine is executed.

45. The method of claim 42, wherein the generated display item comprises a reproduction of the message when the analyzing step determines that the size of the message is less than a predetermined size.

46. The method of claim 42, wherein:

the generated display item comprises a reproduction of the message when the size of the message is greater than a predetermined size; and

the method further comprises the step of providing the generated display item to the display for a predetermined time.

47. The method of claim 46, further comprising the steps of:

generating a further display item that comprises a portion of the message when the size of the message is greater than a predetermined size; and

providing the further display item to the display after the predetermined time has elapsed.

48. The software system of claim 42, wherein the message is transmitted to the communication device via a broadcast network.